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PTO/SB/33 (07/05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		1031/1	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR		Application Number	Filed
on <u>12/17/2007</u>		09/849,297	05/04/2001
Signature <u>Marjorie Scariati</u>		First Named Inventor	
Typed or printed name <u>Marjorie Scariati</u>		Robert Miles Saunders	
		Art Unit	Examiner
		3626	Michael Tomaszewski
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the		<u>Ann A. Wiczorek</u>	
<input type="checkbox"/> applicant/inventor.		Signature	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		<u>Ann A. Wiczorek</u>	
<input type="checkbox"/> attorney or agent of record.		Typed or printed name	
Registration number _____		<u>619-846-4850</u>	
		Telephone number	
<input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34.		<u>12/17/2007</u>	
Registration number if acting under 37 CFR 1.34 <u>48087</u>		Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input checked="" type="checkbox"/> Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Reasons for requesting pre-appellate review:**The Rejection under 35 U.S.C. 103 based on Baldwin in view of Banks is Erroneous**

Claim 22 stands rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Ben G. Baldwin, "The New Life Insurance Investment Advisor" pp. 45-47 (McGraw-Hill 1994) (hereinafter "Baldwin") in view of U.S. Patent No. 5,913,198 to Banks (hereinafter "Banks"). This rejection is erroneous.

As set forth in amended claim 22, a computer-implemented method for managing terms and conditions of a contract for an investment style life insurance policy including at least a term insurance component and an investment component for an insured over a computer network is disclosed and claimed. The computer-implemented method includes (I) receiving by an issuer of the investment style life insurance policy a designation from the insured of a replacement for the term insurance component or the investment component; (II) revising the investment style life insurance policy with a replacement component responsively to the designation from the insured; and then (III) issuing under the terms and conditions of the contract, the revised investment style life insurance policy having the replacement component.

Among other requirements, to establish a prima facie case of obviousness, the prior art reference (or references) must teach or suggest all the claim limitations. *See, e.g.,* MPEP 706.02(j) and the cases cited therein. Baldwin and Banks fail to meet this threshold.

First, Applicant notes that Baldwin discloses a "1035 Tax-Free Exchange". In this system, an insured makes an absolute assignment of a current insurance contract to the same or another company, and the insured further trades the policy in on a new contract without incurring current tax liability. Once the absolute assignment is complete, the new insurance company directs the old insurance company to drop the old policy and send a check for the proceeds directly to the new insurance company. In other

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words, accumulated funds in one life insurance policy can be transferred to another without a taxable event occurring.

The Examiner argues that Baldwin discloses the entirety of the preamble of claim 22, and portions of the step limitations therein. In particular, with regard to step I, the Examiner alleges that Baldwin discloses receiving by an issuer of the investment style life insurance policy designation of the term insurance component or the investment component by the insured, but not (A) where the receiving (or issuing) is performed via a computer network, nor (B) where the designation is of a replacement for the term insurance component or the investment component. With regard to step II, the Examiner alleges that Baldwin discloses issuing by the issuer the investment style life insurance policy, but not (C) revising by the issuer the investment style life insurance policy, nor (D) revising by replacing a component responsively to the designation. With regard to step III, the Examiner alleges that Baldwin discloses issuing under the terms and conditions of the contract and by the issuer the investment style life insurance policy to the insured, but does not disclose (E) that the revised insurance policy contains a replacement component, nor (F) that such a replacement was made responsively to the designation.

Applicant submits that Baldwin also lacks claim limitations beyond those already noted by the Examiner. First, (G) Baldwin lacks disclosure that the investment style life insurance policy includes at least a term insurance component; rather, the policies that Baldwin discusses are uniformly whole life policies, which in many ways are the opposites of term life policies. Second, (H) Baldwin fails to disclose issuing the new policy by the same issuer (Baldwin deals with exchanges of policies, although in some instances a policy may be exchanged for another within the same issuer).

The Examiner then alleges that all the limitations that were not found are old and well-known in the art, as evidenced by Banks, in particular in the Abstract, in Fig. 1, and in column 5, lines 57-60. Applicant disagrees.

Banks purports to disclose a computer-implemented system and method for designing and administering self-funded survivor benefit plans. An insurance component is provided, admittedly, but this component is solely for the purpose of providing

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insurance for individuals who have been identified by the system as being "high risk", and other individuals, in order to limit the liability and tax exposure of the benefit plan.

Accordingly, Applicant admits that Banks provides a level of disclosure that is missing from Baldwin, to wit, that a computer-implemented system and method can be employed to determine whether to purchase insurance contracts. Applicant further admits that the reference discloses both universal life and term life insurance policies, as well as a combination of the same, although it seems clear that the "combination" disclosed is with respect to issuing policies of different kinds, rather than a combination policy to a single policyholder. However, the reference is silent on missing elements (B) – (H) above, as is explained in more detail below.

In particular, Banks lacks disclosure of (B) receiving a designation pertaining to a replacement for a term insurance component or an investment component. Banks merely discusses the purchase of life insurance for high risk and other individuals, so Banks' silence is understandable. The reference never contemplates such a system or step of replacing a portion of an insurance policy. As a consequence, Banks fails to describe missing elements (C) – (F), which concern revising the policy by replacing the designated component, either term or investment. Similarly, Banks fails to disclose element (H), which concerns from where the new policy is issued, i.e., the same issuer as the prior policy. The reason for the lack of disclosure is as above: Banks never contemplates replacing the policy or a portion thereof.

Banks also fails to explicitly disclose element (G), in which the life insurance may be composed of a combination of a term insurance component or an investment component. Banks discloses different types of insurance, and states that a combination of such types may be issued on an individual or group basis, but it seems clear that even the individual basis mentioned is intended to reference providing a single type of insurance to a single individual in addition to providing insurance to a group. The reference nowhere states what types of combination policies are available on an individual basis, and indeed it can be concluded that the same is never contemplated, nor disclosed or suggested.

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Even assuming, arguendo, that Banks disclosed what was missing from Baldwin, the references are not properly combinable. In particular, Applicant notes that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed inventions. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). In this case, Banks clearly teaches away from the claimed invention, and is furthermore not properly combinable with Baldwin so as to result in a *prima facie* case of obviousness.

Regarding teaching away, Banks discloses purchasing of insurance contracts, but only so as to result in a system that is not based on insurance. In particular, the system is disclosed to be "self-funded", and is thus said to be preferable to "prior art insurance-based plans" (column 3, lines 50-59). This aspect is specifically stated as the first-listed advantage over the prior art, and this aspect is oft-repeated, e.g., at column 7 lines 45-47 and at column 9 lines 43-47. Thus, Banks itself teaches away from the use of computer-implemented systems and methods for managing insurance contracts. Regarding combinability, Banks' teaching away clearly would result in one of ordinary skill in the art not combining the same with Baldwin, which entirely concerns purchase and exchange of whole life policies.

In summary, the combination of Baldwin and Banks fails to disclose all the limitations of the claims, the two are not properly combinable, and at least one reference teaches away from the claimed invention. For at least the above reasons, it is respectfully submitted that the cited references do not support a *prima facie* case of obviousness against claim 22.

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Docket: 1031/1

William Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

09/849,297

2-page Petition for Extension of Time, Notice of Appeal and Pre-Appeal Brief Request for Review
1-page Pre-Appeal Brief Request for Review, form PTO/SB/33
4-page Reasons for Requesting Pre-Appellate Review

RECEIVED IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

VIA First Class Mail
Mailed: 12/17/2007

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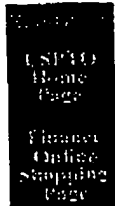
Re: 09/849,297

1. 2-page Petition for Extension of Time, Notice of Appeal and Pre-Appeal Brief Request for Review
2. 1-page Pre-Appeal Brief Request for Review, form PTO/SB/33
3. 4-page Reasons for Requesting Pre-Appellate Review





**United States
Patent and
Trademark Office**



Deposit Account Statement

Requested Statement Month: December 2007
Deposit Account Number: 501047
Name: MAYER & WILLIAMS PC.
Attention:
Street Address 1: 251 NORTH AVENUE WEST, 2ND FLOOR
Street Address 2:
City: WESTFIELD
State: NJ
Zip: 07090
Country: UNITED STATES

DATE	SEQ	POSTING REF TXT	ATTORNEY DOCKET NBR	FEE CODE	AMT	BAL
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